

REMARKS/ARGUMENTS

Claims 1-5, 9, 10 and 13-24 remain in this application. Applicants request reconsideration of this application in view of these remarks and arguments.

Allowable Subject Matter

The Examiner has allowed Claims 1-5, 9, 10 and 13-23.

Claim Rejections – 35 USC § 103

The Examiner has rejected Claim 24 under 35 U.S.C. 103(a) as being unpatentable over Smith, et al. (USPN 6,714,557) in view of Oliver (USPN 6,292,484) in further view of Cantoni, et al. (USPN RE37,494). Applicants traverse these rejections.

To establish a *prima facie* case of obviousness, and hence to find Claim 24 unpatentable under 35 U.S.C. § 103(a) over the combination of Smith, et al., Oliver and Cantoni, et al., three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based upon applicant's disclosure. MPEP at §2142. In the present case, all three criteria are not met because the combined teachings of Smith, et al., Oliver and Cantoni, et al. references do not teach or suggest all of the claim limitations of Claim 24.

Applicants continue to maintain their previous arguments but focus on one argument in particular in this reply. Applicants continue to contend that Smith, et al. (in addition to the other references) fails to disclose the limitations of “*wherein the field is one of a synchronization field and a signaling field*”. Applicants maintain that this language should be interpreted in the alternative, such that the field can be either one of a synchronization field or a signaling field but not both. The Examiner argues that “the claim

does not forbid the field from being both”. Applicants disagree. The claim language does forbid the field from being both a synchronization field and a signaling field at the same time when interpreted “in light of the specification” as required by MPEP §2111. An alternative reading of either a synchronization field or a signaling field but not both has an express basis in the claim language which requires “one of” the two fields. The specification supports this alternative reading, specifically stating on page 3, lines 28-30 that “[t]he present invention uses a *single* embedded field in a burst structure as *either* a synchronization field *or* a signaling field” and page 4, lines 15-18 “[w]hen the number of bits available in a single burst is insufficient to provide dedicated fields for both embedded synchronization and embedded signaling, the present invention defines a burst structure having a single embedded field 300 that is able to support *either* synchronization *or* signaling”. None of the references cited by the Examiner disclose such a burst structure.

Since limitations are missing from the combined teachings of Smith, et al., Oliver and Cantoni, et al., Applicants request that the Examiner remove the 103(a) rejections to Claim 24 and allow this claim.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant’s attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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